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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,749	10/07/2003	Philipp Lang	2960/112	8140
75059      7590      05/20/2008 BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
05/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/681,749

**Applicant(s)**

LANG ET AL.

**Examiner**

Pedro Philogene

**Art Unit**

3733

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36, 38-69, 76-78, 80, 84 and 93-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36, 38-69, 76-78, 80, 84 and 93-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/14/08, 5/2/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/29/08 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-36, 38-69, 76-78, 80, 84, 93-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felt et al. (6,652,587) in view of Hollister (5,522,900).

With respect to claims 1, 34, 80, 84, , 93, Felt et al. disclose an articular implant having a first surface and a second surface wherein the first surface opposes a first articular surface joint and the second surface opposes a second articular surface of the joint, as best seen in the FIGS; and further wherein a portion of at least a portion of each of the first and second surfaces has a three-dimensional shape that either substantially conforms with or duplicate the shape of the first articular surface, such that the movement of the implant in the joint is limited without an attachment mechanism; as set forth in column 4, lines 20-67, column 5, lines 1-67, column 6, lines

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1-67, column 7, lines 1-67, column 8, lines 1-67, column 12, lines 40-67, column 13, lines 1-10, column 14, lines 50-60, column 17, lines 50-67, column 18, lines 1-67, column 19, lines 1-67, column 20, lines 1-67 column 21, lines 1-67, column 22, lines 1-67 column 23, lines 1-67. As to a first component of the plurality of components engages a second component of a plurality of components in at least one of slidably and rotatably, see column 13, lines 10-67, column 14, lines 1-67, column 15, lines 1-58, and as best seen in the FIGS.

With respect to claims 2-33, 35-36, 38-69, 94-96, Felt et al discloses all the limitations, as set forth in column 4, lines 20-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-67, column 8, lines 1-67, column 12, lines 40-67, column 13, lines 1-10, column 14, lines 50-60, column 17, lines 50-67, column 18, lines 1-67, column 19, lines 1-67, column 20, lines 1-67 column 21, lines 1-67, column 22, lines 1-67 column 23, lines 1-67.

With respect to claims 76-78, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

It is noted that Felt et al did not teach of a surface having at least one of a convexity and a concavity on the first and second surfaces of the implant or a plurality of convexities and a plurality of concavities on the first and second surfaces of the implant; as claimed by applicant. However, in similar art, Hollister provides the evidence of an implant having a surface having at least one of a convexity and a concavity on the first and second surfaces of the implant or a plurality of convexities and a plurality of

concavities on the first and second surfaces of the implant to correctly mimic the anatomical structure of the joint being replaced.

Therefore, given the teaching of Hollister, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Felt et al., as taught by Hollister to provide a surface in the implant to correctly mimic the anatomical structure of the joint being replaced.

### ***Response to Amendment***

Applicant's arguments, see Remarks, filed 2/29/08, with respect to the rejection(s) of claim(s) 1-36, 38-69, 76-78, 80,84, 93-96 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hollister. The examiner agrees with applicant Felt et al did not teach of a concavity or convexity on the first and second surfaces of the implant; as claimed by applicant. However, Hollister discloses an implant to replace a joint surface having a plurality of convexities and a plurality of concavities to correctly mimic the anatomical structure of the joint to be replaced; asset forth in column 6, lines 7-60.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,549,690

8-1996

Hollister et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-

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4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
May 15, 2008